

REMARKS

This paper is being presented in response to the Office Action dated June 4, 2004, wherein claims 1-5, 8, 9, 28-31, and 37-41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fukai et al. U.S. Patent No. 4,542,452 ("Fukai"), either taken alone or in view of official notice taken by the Examiner.

Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

Claims 1-54 are pending in this case, with claims 49-54 having been added by the foregoing amendments. Of those, claims 1-5, 8, 9, 28-31, 37-41, and 49-54 are at issue, while claims 6, 7, 10-27, 32-38, and 42-48 have been withdrawn from consideration. Applicants are appreciative of the Examiner's acknowledgement that the subject matter of claims 1-5, 8, 9, 28-31, and 37-41 should be examined. The Applicants, in turn, acknowledge the finality of the Examiner's determination. Nonetheless, it is respectfully submitted that the Applicants have timely traversed the restriction/election requirement set forth in the Office Action dated February 6, 2004, and, as a result, retained the right to petition from the requirement. See MPEP 821.01.

I. Brief Summary of the Amendments

By the foregoing amendments, claims 1, 28, and 39 have been amended, and claims 49-54 have been added.

A. Amendments to Claims 1, 28, and 39

Independent claims 1, 28, and 39 have been amended to specify that configuration information can be downloaded from the distributed process control system. No new matter has been added, inasmuch as support for these amendments can be found at, for example, page 6, lines 20-24; Fig. 4; and, page 12, lines 24-27, of the application as originally filed.

B. Added Claims 49-54

Added claims 49-54 depend either directly or indirectly from independent claims 1, 28, and 39, respectively, and recite limitations that are directed to the nature of two elements recited in the generic claims as originally filed, namely, the

configuration communication port and the distributed process control system. The recited limitations are directed to embodiments that are not mutually exclusive of the species of claims considered by the Examiner. For these reasons, the subject matter presented by added claims 49-51 do not require a separate classification or a different field of search. It follows that the subject matter of added claims 49-54 is not directed to a non-elected species.

No new matter has been added by the foregoing amendments adding claims 49-54. See, for example, page 11, lines 28-30, of the application as originally filed, as well as those portions of the application cited above in connection with the amendments to claims 1, 28, and 39.

II. The 35 U.S.C. § 102(b) Rejection is Traversed

Claims 1-5, 8, 9, 28-31, and 37-41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fukai, either taken alone or in view of official notice taken by the Examiner. Applicants respectfully traverse these rejections, and the assertions and determinations therein, for at least the following reasons. Applicants respectfully request reconsideration and withdrawal of these rejections.

Each of independent claims 1, 28, and 39, as amended, recites, in part, a controller that can operate as a stand-alone controller or as one of a plurality of controllers within a distributed process control system from which configuration information can be downloaded. Fukai does not teach or suggest these elements for at least the following reasons.

In contrast, the cited portions of Fukai describe a controller limited to use as a stand-alone device or in a cascaded or parallel arrangement with another controller of like design. In each arrangement taught by Fukai, a controller can only be programmed using a dedicated programmer separate and apart from the controller arrangement, or from any distributed process control system. See Fukai, Figs. 1 and 2, and col. 10, line 50 – col. 12, line 14. Each controller must be configured individually, exactly as a stand-alone device is programmed. The controller of Fukai, therefore, is not as versatile as a controller which can also operate as one of a plurality of controllers of a distributed process control system from which configuration information is downloaded, as recited in claims 1, 28, and 39. It is therefore

respectfully submitted that Fukai fails to teach a controller wherein configuration information can be downloaded from a distributed process control system, as recited in claims 1, 28, and 39.

Reference is made by the Examiner to the portions of Fukai describing operation of a cascade control function program (CSC), where two process controllers are connected in series. See Fukai, col. 7, lines 30-33. Even if the cascaded controller arrangement of Fukai constitutes a distributed process control system, as recited in claim 1, the programmer cannot be considered to be part of the distributed process control system, insofar as the controller cannot execute the CSC function, or otherwise operate as recited in claims 1, 28, and 39, unless the programmer is disconnected. See, for example, col. 5, lines 59-68; col. 6, lines 1-6; and, col. 13, lines 23-27.

For these reasons, Applicants further respectfully submit that Fukai also fails to suggest downloading configuration information from a distributed process control system. If the controller of Fukai cannot operate unless it is disconnected from the source of programming information, then the controller of Fukai is incompatible with operation within a distributed process control system from which configuration information can be downloaded. That is, the controller of Fukai would be rendered inoperable for its intended purpose if made a part of a distributed process control system from which configuration information can be downloaded.

For at least the reasons set forth above, it is respectfully submitted that Fukai fails to disclose or suggest every element of independent claims 1, 28, and 39. It follows that claims 1, 28, and 39 and, by implication, those claims dependent thereon, are patentable over the cited reference.

The official notice taken by the Examiner in connection with the rejections of dependent claims 4, 30, and 41 is based on an acknowledgment that Fukai fails to teach a controller having a MODBUS TCP communication port. While these rejections have been rendered moot by the foregoing positions taken regarding independent claims 1, 28, and 39, Applicants respectfully traverse the assertion that it would have been obvious to modify the teachings of Fukai to include a MODBUS TCP communication port, as recited in claims 4, 30, and 41. Even if official notice is properly taken in this context, a suggestion or motivation to modify the teachings of

Fukai is lacking because the nature of the communications in Fukai would not benefit from a communications protocol designed for networked devices.

Added dependent claims 49-54 are patentable over Fukai for at least the reasons set forth above in connection with each of independent claims 1, 28, and 39, as well as because Fukai fails to disclose or suggest a controller for which configuration information can be downloaded from a distributed process control system via a configuration communication port (claims 49, 51, and 53), much less one connected, via the configuration communication port, to a bus of the distributed process control system that connects the plurality of controllers (claims 50, 52, and 54).

For at least the reasons set forth above, Applicants respectfully request allowance of the claims at issue, namely claims 1-5, 8-9, 28-31, 39-41, and 49-54. Furthermore, Applicants respectfully request allowance of the claims held to be directed to non-elected species, insofar as each generic claim identified by the Examiner should now be allowed. Accordingly, Applicants respectfully request allowance of claims 1-54.

III. Conclusion

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and allowance of claims 1-54.

Although Applicants believe that the check attached hereto addresses any fees that are due as a result of the foregoing amendments, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. In addition, if a petition for an extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, Applicants request that the Commissioner consider this paper to be a request for an appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to Deposit Account No. No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call their attorney at the number listed below.

Respectfully submitted,

SHEPARD, ET AL.

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